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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,263	03/03/2004	Hiroshi Abe	42530-6700	3995
7590 05/06/2005				
Joseph W. Price SNELL & WILMER L.L.P. 1920 Main Street, Suite 1200 Irvine, CA 92614-7230			EXAMINER WALSH, DANIEL I	
			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/792,263

Applicant(s)

ABE ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

(M)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 15 is/are allowed.
- 6) ☒ Claim(s) 10, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 11 and 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto (US 5,729,000).

Re claim 10, Sugimoto teaches a smart card handling device including a passageway for transporting the card, comprising a first base (10) disposed adjacent the transporting passageway (22); and a second base (20/30) disposed adjacent to the transporting passageway and located opposite from the first base so that the transporting passageway defines a path between the first and second base, wherein the second base is one of a contact type smart card communication unit and a non-contact type smart card

communication unit for communicating with a predetermined type of smart card located along the transporting passageway (FIG. 2). The Examiner also notes that (US 6,116,933 FIG. 1+ can be interpreted as reading upon the claim). Though Sugimoto is silent to the use of a predetermined card, the Examiner notes that the type of card is interpreted to be predetermined, since it is known what type of card would be inserted, before the card is inserted (in normal use). Re claim 12, the limitations have been discussed above. The recitation "different types of smart cards" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The Examiner notes that the claims merely require one or the other of a contact or non-contact type card to be read, not both at the same time, and therefore reads upon the claims. Additionally, even when considering the phrase, the Examiner notes that "types of smart card" can be interpreted as cards of a different manufacturer, those that contain different types of data (credit card type smart card, personal id type smart card, MasterCard, AMEX, authentication, etc.) and are not limited to only contactless and contact smart cards. Therefore, the Examiner notes that even when giving "types of smart cards" patentable weight, that the prior art, though silent reads upon the claims, as the Examiner notes that it is well known and conventional that contact smart cards can be of various types (not specifically limited to contactless and contact type) and that the system as taught by the prior art is capable of

reading such contact smart cards. The Applicant has not specified in the claims that the card type is specifically contact and contactless smart cards.

2. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwamoto et al. (US 6,216,954).

Re claim 13, Kuwamoto et al. teaches a card receiving unit for receiving a card from a user and transporting the card to the interior of the card handling device, the card receiving unit for dispensing a card to a user, the card being one of a magnetic card, a non-contact type smart card, and a contact type smart card (through port 4). Kuwamoto teaches first transporting unit for receiving the card from the card receiving unit and reversibly transporting the received card along a transportation passageway, a magnetic card handling unit for communicating with a magnetic card, the magnetic card handling unit being disposed along the transporting passageway and receiving a card from the first transporting unit and a second transporting unit for receiving the card from the first transporting unit and reversibly transporting the card along the transporting passageway, through the card insertion port 4 (FIG. 1). Kuwamoto et al. teaches means for communicating with a non-contact type smart card through antenna 17.

Though Kuwamoto et al. is silent to a communication board-attaching unit for receiving the non-contact communication board, where the communication board-attaching unit includes a universal attachment section for releasably attaching the board, the Examiner notes that FIG. 4A+ teaches a circuit board including holes for attachment. The Examiner notes that it is well known and conventional that holes in circuit boards for attachment are typically releasably to permit removal of the board. Accordingly, the Examiner interprets that the holes depicted in the circuit board are for attachment (with

releasable attaching means) and therefore is broadly interpreted to include a communication board-attaching unit including universal attachment means (as the board would be attached to the device for securing the board in a fixed position). Again, though silent to universal/releasably attaching means, the Examiner notes it's well known and conventional to secure boards in a releasable fashion, to secure them in a body/housing to reduce damage by movement of the boards.

Allowable Subject Matter

3. Claims 1-9 and 15 are allowed.
4. Claims 11 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. The following is a statement of reasons for the indication of allowable subject matter: Re claims 1-9 and 15, The prior art of record fails to teach a smart card handling device with a communication board attaching unit comprising a first base and a second base for mounting to the first base, the second base having a first communication board and second communication board attaching section for receiving communication boards for communicating with non contact cards. Re claim 11, the prior art of record fails to teach one touch attaching units being disposed between the passageway and the first base and between the passageway and the second base, comprising complementary mating sections for mounting the bases. Re claim 14, the prior art of record fails to teach a recycling unit that pivots the communication board-attaching unit. Such modification of

the prior art to teach the above mentioned claims is not deemed obvious to one of ordinary skill in the art, by the Examiner.

Conclusion

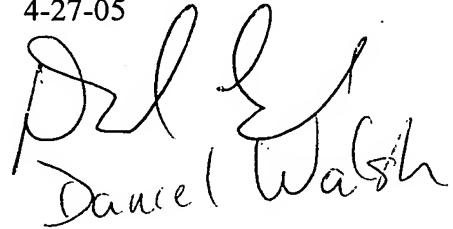
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Oki et al. (US 6,616,050), Willhite (US 6,116,933), Benjamin et al. (US 6,168,082), Someya et al. (US 5,698,832), Shimamura et al. (US 4,602,351), Hirasawa (US 6,250,552), Wong et al. (US 5,912,446), Mita (US 5,010,239), Abe et al. (US 6,866,201), Inoue (US 6,085,974), Moriya (US 5,984,183), Kashima (US 6,519,158), Ohwa et al. (US 5,850,079), Hsiao (US 6,830,194), Chang (US 6,146,195), Saroya (US 5,554,840), Kowalski et al. (US 6,839,772), Cesaire et al. (US 6,082,615), Kreft (US 6,068,186), Jubert (US 6,068,1863 and US 6,068,186), Kawagishi (US 6,411,200), Bashan et al. (US 6,045,043), Saitoh (US 5,929,414), Huis et al. (US RE35,992), Kenneth et al. (US 5,594,233), and Inoue (US 5,382,781).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
4-27-05

A handwritten signature in black ink, appearing to read "Daniel I Walsh", is written over the typed name and date.